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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/002,952

11/15/2001

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70801-56710

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01/09/2008

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EXAMINER

ANGEBRANDT, MARTIN J

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

01/09/2008

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUYUKI TAKAMORI,
HIDEHARU TAJIMA and
AKIRA TAKAHASHI

Appeal 2007-3146
Application 10/002,952
Technology Center 1700

Decided: January 9, 2008

Before BRADLEY R. GARRIS, PETER F. KRATZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is in response to a Request, filed November 15, 2007, for rehearing of our Decision, mailed September 25, 2007, wherein we AFFIRMED the Examiner's § 102 rejection of all appealed claims as being anticipated by Tajima.

Appellants seem to believe (Request 2-3) that the appealed claims distinguish from the 4-layer structure of Tajima's Table 5 embodiment. This is incorrect. We find nothing, and Appellants point to nothing, in the appealed claims which excludes such a structure.

Moreover, Appellants erroneously imply that Tajima is directed to reducing media warpage caused by temperature changes only (Request 3, last sentence). As explained in our opinion (Decision 5), Tajima (like Appellants) also is directed to reducing warpage caused by changes in humidity (Tajima ¶¶ [0004], [0012]).

Finally, Appellants argue that, "even if certain embodiments of the media disclosed in the Tajima reference have warpage angle properties similar to the claimed media, this is not evidence that the thin film protective layer of Tajima inherently must have the properties as recited in the present claims" (Request 4). However, as explained on pages 5-6 of the Decision, the recording medium disclosed and claimed by Appellants and the recording medium disclosed by Tajima possess multiple commonalities and overlapping values including materials of construction, thicknesses, and warpage angles. For these reasons, we remain convinced that "there is a reasonable basis in fact for believing that Tajima's thin film protective layer inherently possesses the claimed expansion coefficient under humidity" (Decision 6). *See Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990).

Significantly, Appellants have failed to provide any evidence in support of their burden to prove that Tajima's optical information recording medium does not inherently possess the characteristics of the here claimed

product (Decision para. bridging 6-7). *See In re Best*, 562 F.2d 1252, 1555 (CCPA 1977). Therefore, we adhere to our decision affirming the § 102 rejection of all appealed claims as being anticipated by Tajima.

The Request for Rehearing is DENIED.

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